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KUBOVCIK & KUBOVCIK

The Farragut Building
Suite 710
900 17th Street, N.W.
Washington, D.C. 20006

TEL: 202-887-9023
FAX: 202-887-9093

To: Mail Stop Amendment
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From: Ronald J. Kubovcik (Registration No. 25,401)
Date: February 23, 2007
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Re :

Appl. No.	:	10/558,275	Confirmation No. 1653
Applicant	:	Keijiro TAKANISHI et al.	
Filed	:	November 23, 2005	
TC/A.U.	:	1711	
Examiner	:	Duc Truong	
Dkt. No.	:	IPE-063	
Cust. No.	:	20374	

Document transmitted herewith: (1) REQUEST FOR NEW ACTION PROPERLY RESPONDING TO TRAVERSAL OF ELECTION OF SPECIES REQUIREMENT AND REQUEST FOR EXAMINATION OF CLAIMS 9-12 ON THEIR MERITS

(Dkt: March 2, 2007)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Ronald J. Kubovcik

REQUEST FOR NEW ACTION PROPERLY RESPONDING TO TRAVERSAL OF ELECTION OF SPECIES REQUIREMENT AND REQUEST FOR EXAMINATION OF CLAIMS 9-12 ON THEIR MERITS

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

February 23, 2007

Sir:

Applicants request withdrawal of the Office Action of February 2, 2007, and issuance of a new Action in which the Office properly responds to applicants' traversal of the election of species (lack of unity of invention) requirement in the subject application and examines claims 9-12 on their merits.

The Office issued an election of species (lack of unity of invention) requirement on November 27, 2006. In the requirement,

the Office required election of one of the following species:

(1) a residue from phosphonic acid,

(2) a residue from thiophosphonic acid,

(3) a residue from selenophosphonic acid,

(4) a residue from phosphonous acid,

(5) a residue from phosphoric acid,

(6) a phosphorous containing residue of the claimed formula (2), and

(7) a phosphorous containing residue of the claimed formula (3).

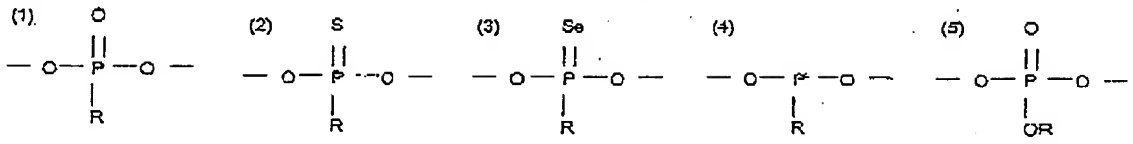
The present application is the U.S. national stage of an international application. Unity of invention practice must be applied by the Office to the present application. In the Election of Species requirement, the Office took the position that unity of invention was lacking under PCT Rule 13.1 because, under PCT Rule 13.2, the groups lack the same or corresponding technical feature because each species has a different chemical structure and requires a different search.

In a response filed December 27, 2006, to the requirement, applicants elected Group (1) as the species and identified claims 1 and 8 to 12 as reading on the elected species. This election was made with traverse on the basis that the Office had not properly

shown a lack of unity of invention in the present application.

Applicants' arguments distinctly and specifically pointing out the errors in the requirement are reproduced below:

> "Applicants respectfully submit that the Office has not properly applied unity of invention practice. Species (1) to (5) are recited in claim 1 as a Markush group. According to Annex B of the Administrative Instructions under the PCT, in the case of Markush groupings, unity of invention exists when the alternatives are of a similar nature. In the case of chemical compounds, a similar nature is present when all alternatives have a common property and a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains. Furthermore, the fact that the alternatives of a Markush grouping can be differently classified shall not, taken alone, be considered to be justification for a finding of a lack of unity of invention. The Office's position that the compounds of species (1) to (5) differ in chemical structures and requires a different search does not show lack of unity of invention in the present application. The Office must show that the compounds lack a common property and a common structural element.
>
> Notwithstanding the impropriety of the Office's position, applicants also submit that species (1) to (5) share a significant structural element. The structure common to the species is a phosphorous atom and bicycloalkyl structure, as illustrated below:



(wherein R contains a bicycloalkyl structure). Additionally, O, S and Se belong to the same group in the periodic table and have similar chemical properties (e.g., an optically low dispersability and a high refractive index).

The Office has also failed to show lack of unity of invention regarding species (6) and (7). Species (6) is recited in claim 2, which recites a dependency on claim 1. Species (7) is recited in claim 3, which recites a dependency on claim 2. Annex B of the Administrative Instructions under the PCT provides that unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. I.e., unity of invention is presumed to exist between an independent claim and all claims dependent thereon. Consideration of unity of invention between an independent and dependent claim is in order only if an independent claim does not avoid the prior art. The Office has not properly shown lack of unity of invention regarding species (6) and (7) since the Office has not shown how claim 1, upon which the claims reciting species (6) and (7) ultimately depend, fails to avoid the prior art."

In the Office Action dated February 2, 2007, the Office merely acknowledges traversal of the requirement. The Office also indicates that only claims 1 and 8 read on the elected species and

has withdrawn claims 2 to 7 and 9 to 12 from consideration. The Office has not responded to the traversal of the election of species requirement, has not indicated whether or not the requirement has been made final, has not explained why claims 9 to 12, which read on the elected species, have been withdrawn, and has not examined claims 9-12 on their merits.

Applicants respectfully request a new Action in which the Office:

A) responds to the specific arguments made in the traversal of the election of species requirement;

B) indicates whether or not the requirement has been made final;

C) rejoins claims 9 to 12; and

D) examines claims 9 to 12 on their merits.

Regarding items (A) and (B), MPEP §821.01 requires that if an election of species requirement is traversed, it should be reconsidered by the Office. If the requirement is still deemed to be proper, then the Office should repeat the requirement and reply to the reasons and arguments advanced by applicant in the traverse. Regarding items (C) and (D), applicants elected a residue from phosphonic acid as the species and identified claims 9 to 12, in addition to claims 1 and 8, as reading on the elected residue from

phosphonic acid. Claims 9 to 12 should not have been withdrawn and should have received an examination on their merits.

In the event any fees are required, please charge our Deposit Account No. 111833.

Respectfully submitted,

KUBOVCIK & KUBOVCIK

Ronald J. Kubovcik
Reg. No. 25,401

Atty. Case No. IPE-063
The Farragut Building
Suite 710
900 17th Street, N.W.
Washington, D.C. 20006
Tel: 202-887-9023
Fax: 202-887-9093
RJK/jbf